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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,136	02/20/2004	Tony M. Pearce	03886.051/5126 P	5374

7590 05/17/2006  
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EXAMINER
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EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,136	<b>Applicant(s)</b> PEARCE, TONY M.	
	<b>Examiner</b> Dr. Kelechi C. Egwim	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.  
 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) See Continuation Sheet is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 7,8,10,11,16,26,27,32,40-72,74,75,82,83,86,87,89-95,97,98,101,102,104-111,119 and 120.

Continuation of Disposition of Claims: Claims rejected are 1-6,9,12-15,17-25,28-31,33-39,73,76-81,84,85,88,96,99,100,103,112-118,121 and 122.

## **DETAILED ACTION**

### ***Priority***

1. With regard to US 08/783,413 and US 60/226,726, applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

### ***Election/Restrictions***

2. Regarding the election of Species A) a., B) b., C) b. and D) a., claims 1-6, 9, 12-15, 17-25, 28-31, 33-39, 73, 76-81, 84, 85, 88, 96, 99, 100, 103, 112-118, 121 and 122,

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because in the reply filed on 03/27/2006, applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. This application contains claims 7, 8, 10, 11, 16, 26, 27, 32, 40-72, 74, 75, 82, 83, 86, 87, 89-95, 97, 98, 101, 102, 104-111, 119 and 120 drawn to inventions nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 9, 14, 15, 17-25, 30, 31, 33-39, 73, 78-81, 88, 96, 103 and 112-118 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearce ('450), for reasons cited in the First Office Action.

6. Claims 1-6, 9, 12-15, 17-25, 28-31, 33-39, 73, 76-81, 84, 85, 88, 96, 99, 100, 103, 112-118, 121 and 122 are rejected under 35 U.S.C. 102(b) as being anticipated by Pearce ('527), for reasons cited in the First Office Action.

***Claim Rejections - 35 USC § 102/103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 14, 17, 21-25, 30, 37-39, 73, 78-80 and 112-118 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Allen et al., for reasons cited in the First Office Action.

***Terminal Disclaimer***

9. The terminal disclaimer filed on 03/27/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,187,837 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Arguments***

10. Applicant's arguments filed 03/27/2006 have been fully considered but they are not persuasive.

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11. Regarding applicant's argument that the present application claims priority to Pearce '450, even though applicant's ¶ 1 in the specification recites that

"08/601,374 filed on February 14, 1996 ... is a continuation-in-part of United States Patent Application No. 08/783,413 filed on January 10, 1997, now U.S. Patent No. 5,994,450"

this is obviously not possible as 08/783,413, which is supposed to be the parent, was filed almost a year **after** 08/601,374. Contrary to applicant's argument, there is no actual priority/continuity chain linking the present application and 08/783,413, now U.S. Patent No. 5,994,450.

12. Regarding US 6,026,527, the parent of the C-I-P case of which the present application is a divisional, US. 09/303,919, does not provide support for the presently claimed elastomeric material with a bleed-reducing agent. As the claimed composition is not supported by said domestic priority application, the oldest priority application with support for the claimed invention is 10/059,101, filed 11/08/2001. US 6,026,527 was published 2/22/2000 and there is no actual continuity chain linking the present invention with the new limitation and U.S. 6,026,527.

13. Regarding Allen et al., as priority for the elastomeric material/bleed-reducing agent combination only goes back to 11/08/2001, a patent published on May 26, 1998 is a statutory bar.

14. Further, Applicants argues that "Allen does not disclose any of the chemicals that Applicant has claimed as a bleed reducing agent". However, Applicant has not identified which compounds in the claims rejected by Allen et al. are not taught by Allen et al, which amount to a general allegation that the claims define a patentable invention. This is not persuasive.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

**KELECHI C. EGWIM PH.D.**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to be 'KE' followed by a stylized flourish.